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Sept. 30, 2002
QUINE INTELLECTUAL PROPERTY LAW GROUP, P.C.

By: Karin Brooks

Atty Docket No: 407E-914026US
Client Ref: 92-005-C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Daniel J. Pinkel; Joe W. Gray; Anne Kallioniemi; Olli-Pekka Kallioniemi; Frederic Waldman

Application No.: 09/912,818

Filed: 7/24/2001

For: **Comparative Genomic Hybridization**

Examiner: Fredman, J.

Art Unit: 1637

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Office Action dated August 28, 2002, Applicants respectfully request reconsideration of the above-identified application in view of the following amendments and remarks.

REMARKS

Status of the Claims.

Claims 45-86 are pending in the application.

Election/Restriction.

In the Office Action, the Examiner noted that the application contains claims directed to patentably distinct species corresponding to the various chromosomal locations recited in the claims. Office Action, page 2. Accordingly, the Examiner indicated:

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Id.

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Applicants note that the Examiner's statement of the election requirement and indication that no claims are generic suggests that the Examiner intends to limit examination in this case to the claims readable on the elected species. However, limiting examination in this manner would contravene the procedure set forth in the M.P.E.P. The independent claims in the present application are Markush claims. Election of species practice relating to Markush claims is governed by M.P.E.P § 803.02, which states:

This subsection deals with Markush-type generic claims which include a plurality of alternatively usable substances or members. In most cases, a recitation by enumeration is used because there is no appropriate or true generic language. A Markush-type claim can include independent and distinct inventions. This is true where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s). In applications containing claims of that nature, ***the examiner may require a provisional election of a single species prior to examination on the merits. The provisional election will be given effect in the event that the Markush-type claim should be found not allowable. Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability.*** If the Markush-type claim is not allowable over the prior art, examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.

As an example, in the case of an application with a Markush-type claim drawn to the compound C-R, wherein R is a radical selected from the group consisting of A, B, C, D, and E, the examiner may require a provisional election of a single species, CA, CB, CC, CD, or CE. The Markush-type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species shall be rejected, and claims to the non-elected species would be held withdrawn from further consideration. As in the prevailing practice, a second action on the rejected claims would be made final.

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected

species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final. Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry.


(Emphasis added.) Thus, the M.P.E.P. makes it clear that (1) Markush claims are a form of generic claim and (2) must be fully examined unless prior art is found that renders one of the recited species unpatentable.

To the extent that the election requirement imposed in the Office Action is contrary to M.P.E.P § 803.02, Applicants respectfully traverse the requirement. Applicants provisionally elect the chromosomal location "about position q22 to about position q24 on human chromosome 17" for prosecution in the present application. The claims that read on this chromosomal location are: 45, 46, 56-61, 68-71, and 74-76.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (510) 769-3509.

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Respectfully submitted,


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TRANSMITTAL FORM

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Application Number

09/912,818

Filing Date

July 24, 2001

First Named Inventor

Daniel Pinkel

Group Art Unit

1637

Examiner Name

J. Fredman

Attorney Docket Number

407E-914026US

ENCLOSURES (check all that apply)

☐ Fee Transmittal Form

☐ Fee Attached

☒ Response to
Restriction
Requirement

☐ Extension of Time Request

☐ Express Abandonment Request

☐ Information Disclosure Statement

☐ Certified Copy of Priority
Document(s)

☐ Response to Missing Parts/
Incomplete Application

☐ Response to Missing
Parts under 37 CFR
1.52 or 1.53

☐ Assignment Papers
(for an Application)

☐ Drawing(s)

☐ Licensing-related Papers

☐ Petition Routing Slip (PTO/SB/69)
and Accompanying Petition

☐ Petition to Convert to a
Provisional Application

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☐ Request for Refund

☐ After Allowance Communication
to Group

☐ Appeal Communication to Board
of Appeals and Interferences

☐ Appeal Communication to Group
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☐ Proprietary Information

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Emily M. Haliday, Reg. No. 38,903, Quine Intellectual Property Law Group P.C.

Signature

Emily M. Haliday

Date

Sept. 30, 2002

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